

REMARKS

Status of the Claims

Upon entry of the present amendment, claims 31, 32, 35-44, 46-52 and 64-66 will remain pending in the above-identified application.

Claim 31 has been amended based on the disclosure at page 10, lines 28-31 of the specification and previous claims 34 and 45, which are cancelled to avoid redundancy with amended claim 31. Claim 33 is also cancelled to maintain consistency with the amended claims.

The present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited.

Claim Rejection under 35 U.S.C. § 112, 1st Paragraph

Claims 31-52 and 64-66 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that claims 32-52 and claims 64-66 are rejected for depending on claim 31 with the new matter. This rejection is respectfully traversed.

In this Amendment, "*C₁-C₈ alkane*" in claim 31 is amended to read "*C₄-C₂₀ alkane*" based on the disclosure at page 11, lines 24-26 of the specification. Withdrawal of the rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 31-52 and 64-66 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The Examiner states that claims 32-52 and 64-66 are rejected for depending on the indefinite claim 31. This rejection is respectfully traversed.

Claim 31 has been amended to recite "*separating from the water and the non-solvent*" (emphasis added). One skilled in the art can reasonably conclude that the inventor had possession of the claimed invention in view of the specification (e.g., working Examples).

In view of the amendments to the claims, reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections under 35 U.S.C. §103(a)

Claims 31-40, 42-48, 50-52 and 64-66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs US '459 (US 6,562,459) in view of Tanaka US '449 (US 6,617,449) and Feuer US '279 (US 5,693,279).

Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs US '459, Tanaka US '449 and Feuer US '279, in view of Rudolph US '392 (US 4,011,392).

Further, claim 49 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs US '459, Tanaka US '449 and Feuer US '279, in view of Portnoy US '186 (US 4,716,186).

Applicants respectfully traverse the rejection and request that the Examiner withdraw the rejections based on the following considerations.

Nonobviousness over the Combination of the Cited References

In this Amendment, claim 31 has been amended by reciting i) the solvent is used in a minimum amount to dissolve the starch derivative or in an amount of up to 30 % by weight more than the minimum amount, ii) a concentration of the starch derivative in the solution is 10-30 %

by weight (as recited in previous claim 34), and iii) an amount of the non-solvent used for precipitation is 0.5-10 times by weight of the amount of the solvent (as recited in previous claim 35). In view of the amendments to the claims, the present invention has been further defined over the combination of the cited references. According to the present invention, starch pigments having excellent optical properties can be effectively obtained (see *e.g.*, the disclosures at page 4, lines 4 to 16 and pages 14, line 27 to page 15, line 2 of the present specification).

It is alleged in the Office Action that claimed invention is obvious over Bengs US '459 in view of the secondary references. However, none of the cited references discloses or suggests such advantageous properties (*e.g.*, optical properties) attained by the present invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, there is no rationale and/or reasonable expectation of success based on the combination of the cited references, by which one skilled in the art could arrive at the present invention as claimed. Thus, it is submitted that the present invention is not obvious over the combination of the cited references.

Based on the foregoing considerations, Applicants respectfully request that the Examiner withdraw the objections and the rejections.

CONCLUSION

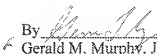
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. 68,859 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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